

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Northeast Express Transportation, Inc.

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Serial No. 75/066,354  
Serial No. 75/066,356  
Serial No. 75/066,363

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Philmore H. Colburn, II of Fishman, Dionne, Cantor &  
Colburn for Northeast Express Transpiration, Inc.

Jeffrey Dalton Martin, Trademark Examining Attorney, Law  
Office 107 (Thomas Lamone, Managing Attorney).

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Before Cissel, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Three applications were filed by Northeast Express  
Transportation, Inc. to register the marks, NEXTCOURIER<sup>1</sup>,  
NEXTDISTRIBUTION<sup>2</sup>, and NEXTAIR<sup>3</sup>. The services listed in the

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<sup>1</sup> Serial No. 75/066,354, filed March 1, 1996, asserting claimed  
dates of first use and first use in commerce of October 27, 1995.

<sup>2</sup> Serial No. 75/066,356, filed March 1, 1996, asserting claimed  
dates of first use and first use in commerce of October 9, 1995.

<sup>3</sup> Serial No. 75/066,363, filed March 1, 1996, asserting claimed  
dates of first use and first use in commerce of October 31, 1995.

first two applications are "courier services for letters, packages, parcels by ground transport"; and the services listed in the third application are "airfreight services."

Registration has been finally refused in all three applications under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when used on its identified services, so resemble the previously registered mark shown below

for "international freight forwarding and shipping by air, sea, truck and rail,"<sup>4</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed<sup>5</sup>, but an oral hearing was not requested.

In view of the common questions of law and fact which are involved herein, we find it in the interests of

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<sup>4</sup> Reg. No. 1,826,645, issued March 15, 1994. The claimed date of first use and first use in commerce is May 3, 1993. The words "EXPRESS INC" are disclaimed.

<sup>5</sup> Applicant's objection to the Examining Attorney's brief as untimely is not well taken. An Examining Attorney's brief is due within 60 days after the date of the Board's written action forwarding the application file to the Examining Attorney. See Trademark Rule 2.142(b)(1) and TBMP §1203.02(b). In this case, the Board forwarded the application file to the Examining Attorney on January 14, 1998. The Examining Attorney timely filed his brief sixty days later on March 16, 1998.

judicial economy to consolidate the cases for purposes of final decision. Thus, we have issued this single opinion. We affirm the refusal to register in all three cases.

The Examining Attorney contends that each one of applicant's marks, NEXTCOURIER, NEXTDISTRIBUTION, and NEXTAIR, is similar in sound, appearance and commercial impression to the cited registered mark, NEXT EXPRESS, INC and design; that while the marks are considered in their entireties, it is proper to give more weight to a particular feature of a mark, and in these cases, the word NEXT is the arbitrary and dominant element of each of applicant's marks as well as of the cited mark, especially because the second word in each of the marks (COURIER, DISTRIBUTION, AIR, and EXPRESS) is a highly suggestive or descriptive term with regard to the involved services; that purchasers will have only general rather than specific recollections of the respective marks; that the third-party registrations cited by applicant<sup>6</sup> are not persuasive because

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<sup>6</sup> Applicant included a list of seven third-party registrations in the field of delivery services (and a general mention of two other registrations in unrelated fields) within applicant's February 25, 1997 response to the first Office action. (Applicant's list includes eight third-party registrations; however, we note that one of the registrations in said list is the registration cited by the Examining Attorney.)

A party may not make third-party registrations of record simply by setting forth a list of third-party registrations. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974); and TBMP §703.02(b). Although the Examining Attorney could have objected to

the commercial impression created by using the arbitrary word NEXT along with a descriptive term (e.g., NEXTCOURIER) is to be distinguished from the marks in the third-party registrations, wherein each includes the word NEXT with another term or terms which create separate commercial impressions and connotations (e.g., NEXT PLANE OUT, NEXT DAY...EVERY DAY); and that the services of applicant and the cited registrant are "identical and would be found in the same channels of trade" (Examining Attorney's first Office action dated August 21, 1996, p. 2).

Applicant counters by contending that the marks of applicant and that of registrant are not similar even though they share one common syllable, NEXT, because applicant's marks are each arbitrary, single, indivisible word marks with no design feature; that when viewed as a whole, and not dissected, applicant's marks, NEXTCOURIER, NEXTDISTRIBUTION, and NEXTAIR are not similar to the cited mark, NEXT EXPRESS INC and design; that NEXT is not the dominant portion of the cited registrant's mark; and that because there are several third-party registrations in the

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applicant's third-party registrations as proffered, he did not do so. In fact, the Examining Attorney treated the third-party registrations as if they were of record. Therefore, the third-party registrations referred to by applicant will be considered by the Board.

field of delivery services, the cited registrant's mark is a weak mark in a crowded field.

Our determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the du Pont<sup>7</sup> factors bearing on the likelihood of confusion issue.

Turning first to a consideration of the respective services, applicant does not dispute, with good reason, that its services and those of registrant are closely related. The services recited in all three of applicant's applications and the services identified in the cited registration all involve the shipping of parcels, packages, and freight through either ground or air as the means of said transport. We note that registrant's freight services are limited to international shipping, but applicant's services are not so limited, and thus could encompass international as well as domestic courier services of letters, packages and parcels and air freight services.

We do not hesitate to find that applicant's courier services for letters, packages and parcels by ground transport and applicant's air freight services are in part overlapping and otherwise closely related to the cited

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<sup>7</sup> See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

registrant's international freight forwarding and shipping by air, sea, truck and rail.

Regarding the respective trade channels and purchasers, again applicant did not argue that these are different. Based on the respective identifications of applicant's services and the cited registrant's services, clearly all could be offered and sold to the same class of purchasers through the same channels of trade. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Turning next to a consideration of the respective marks, we begin with the premise that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). We find that each of applicant's three applied-for marks and the cited registered mark, when considered in their entirety, engender similar overall commercial impressions.

We recognize that the words EXPRESS INC and the design feature of registrant's mark cannot be ignored. See *Giant Food, Inc. v. National Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, although we resolve the likelihood of confusion upon consideration of

the marks in their entireties, there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In the case now before us, we have given more weight to the identical NEXT portion in each of applicant's marks and in registrant's mark because of the descriptive nature of the remaining portion of each mark--"courier", "distribution", and "air" in applicant's marks, and "Express Inc" in the cited registrant's mark. Further, the design element of the cited mark consists of stylized lettering of the word NEXT with a highly stylized letter "X." This design feature thus emphasizes the word NEXT, which is clearly the dominant part of the registered mark.

Because of the overall similarity of the marks, purchasers who are familiar with registrant's NEXT EXPRESS INC and design mark for international freight forwarding and shipping services are likely, upon encountering NEXTCOURIER and NEXTDISTRIBUTION for courier services of letters, packages and parcels, and NEXTAIR for air freight services, to believe these all identify services emanating from a single source. Moreover, the minor differences between applicant's marks and the cited mark are not likely to be recalled by purchasers seeing the marks at separate

times. The recollection of the average purchaser is normally a general rather than a specific impression of the many trademarks encountered, and the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988); and *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255, 259 (TTAB 1980).

Applicant argues that the word NEXT is weak because there are several third-party registrations in the field of delivery services which include the word NEXT in the mark. Third-party registrations are not evidence of commercial use of the marks shown therein, or what happens in the marketplace, or that consumers are familiar with the third-party marks. See *Olde Tyme Foods Inc., v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd*, Appeal No. 92-1086 (Fed. Cir. June 5, 1992). Such registrations are competent to show that others in a particular industry have registered marks incorporating a particular term, or that the common term in the marks has a normally understood meaning or suggestiveness in the industry. See *In re Hamilton Bank*,



222 USPQ 174 (TTAB 1984). See also, In re Great Lakes Canning, Inc., 227 USPQ 483 (TTAB 1985).

Applicant has not shown that the word NEXT, by itself, is suggestive or descriptive of courier or freight shipping services. Further, we agree with the Examining Attorney that each of the marks in the third-party registrations consists of the word NEXT along with other non-descriptive words (e.g., NEXT BUS OUT; MIDWEST DELIVERY. NEXT TIME; NEXT DAY...EVERY DAY), resulting in each third-party mark forming a separate connotation and commercial impression different from the others. That is, even though the third-party marks each include the word NEXT, nonetheless, the connotations of each third-party registered mark is different from all of the others (e.g., NEXT BUS OUT connotes the idea that the package will be transported promptly by being on the next bus; MIDWEST DELIVERY. NEXT TIME connotes the idea to think of this company and to hire them the next time a package needs to be shipped; NEXT DAY...EVERY DAY connotes the idea of consistently prompt delivery).

Moreover, the Board does not have the files of the third-party registrations before us; and, in any event, third-party registrations do not justify the registration of another confusingly similar mark. See Plus Products v.

Star-Kist Foods, Inc., 220 USPQ 541 (TTAB 1983).

Applicant's list of seven third-party registrations is not evidence of use of the referenced marks, so it cannot be convincing that the cited registrant's mark is a weak mark in its field.

Any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Decision: The refusal to register under Section 2(d) is affirmed in each application.

R. F. Cissel

B. A. Chapman

D. E. Bucher  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board